

REMARKS

Claims 19-29 and 32-43 are pending in the present application.

Reexamination of the application, reconsideration of the rejections and objections and withdrawal of the finality of the Office Action are respectfully requested in view of the following remarks. Upon withdrawal of the finality of the Office Action, Applicants request the Examiner's consideration of the Information Disclosure Statement being filed concurrently.

I. Interview Summary mailed December 5, 2008

Applicants' Reply filed November 25, 2008 contained the following statement:

Applicants sincerely thank Examiner Loewe for the helpful telephonic interview conducted November 24, 2008, between the Examiner and the undersigned attorney. During the interview, the data in Table 3 was specifically pointed out by the attorney. Other issues discussed include the extent of searching performed on the claimed genus.

In view thereof, Applicants believe a complete written statement as to the substance of the interview has already been made of record.

II. Claim Objections

In view of the arguments set forth below, Applicants respectfully request that the objection to claims 19, 23-27, 32 and 38-43 be withdrawn and the search extended.

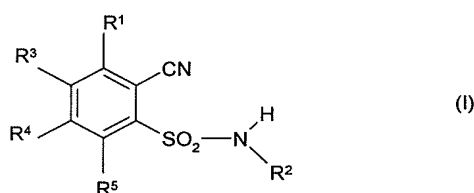
III. Claim Rejections Under 35 U.S.C. § 102(b)

Claims 19, 26 and 32 have been rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by Martin et al. (USPN 3,888,897) ("Martin"). OA p. 3. Applicants respectfully traverse the rejection.

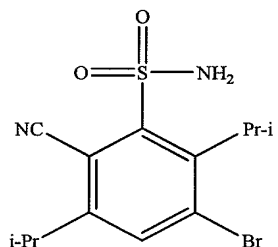
To anticipate a claim, the Federal Circuit has held that, "a single prior art reference must expressly or inherently disclose each limitation.... But disclosure of each element is not quite enough-this court has long held that anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention *arranged as in the claim.*" *Net MoneyIn*,

Inc. v. Verisign, 545 F.3d, 1359, 1371 (Fed. Cir. 2008) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542 at 1548) (Emphasis in original). “[The] reference must clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without *any* picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” *Sanofi-Synthelabo v. Apotex, Inc.*, 550 F.3d 1075 (Fed. Cir. 2008) (quoting *In re Arkley*, 455 F.3d 586, 587) (Brackets in original) (Emphasis in original).

Present claim 19 is directed to compounds of formula I having the following structure:

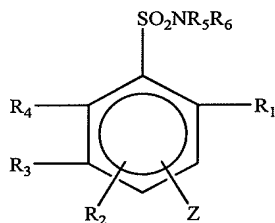


In the above structure, the group adjacent to the cyano is R¹, and it can have a value of C₁-C₂-alkyl. Claim 26 further defines the compounds of claim 19. Claim 32, on the other hand, is directed to a composition comprising a compound of formula I, wherein R¹ can be C₁-C₄ alkyl. In the Office Action, it is alleged that the following structure anticipates claims 19, 26 and 32:



It is evident that this structure has an isopropyl group adjacent to the cyano. At page 3, the Office Action states that the above compound anticipates a presently claimed species when “R¹=R⁵=alkyl.” However, the presently claimed compounds do not include “alkyl” other than C₁-C₂-alkyl. Therefore, the cited compound cannot anticipate the present compound claims.

Further, the compound shown in the Office Action cannot be expanded to include any “alkyl” other than the *i*-Pr group shown. The term “alkyl” as used in Martin refers to the genus structure at column 1:



According to Martin, R₁, R₂, R₃ and R₄ can be “alkyl of 2 to 7 carbons” with certain provisos, but, in any case, the values cannot be cyano. *See*, col. 1, lines 46-64. Z can be cyano, but it is evident from the above structure that it cannot be adjacent to the sulphonamide. These adjacent positions are held by R₁ and R₄. Therefore, the compound recited in the Office Action is disclosed as a specific compound in Martin, but it cannot be a member of the genus of Martin at least because it has a cyano adjacent to the sulphonamide moiety.

With regard to compounds that can have a cyano adjacent to the sulphonamide moiety, Martin only discloses one such 2- or 6-cyano compound, 5-Bromo-2-cyano-3,6-diisopropylbenzenesulfonamide. *See*, Example 5, column 9, lines 17-18. This is the structure shown above as recited in the Office Action. There is one other compound described in Example 5. It falls into the genus of Martin and is further described in Table 2 under Example 5. As discussed above, the compound of Example 5 shown in the Office Action cannot fall under the genus in Martin. As such, the definitions and uses of the genus cannot be imputed to this compound because it would be improper under 35 U.S.C. § 102 to go “picking, choosing or combining” definitions and uses from a genus and applying them to a separate structure as if it were a member of the genus. *See, Sanofi-Synthelabo*. Moreover, this compound which is outside the genus of Martin is not disclosed as being formulated into a composition. The compositions of Martin only include the compounds of the genus because Martin limits the compositions: “The compounds of Formula (1) can be formulated for herbicidal use....” Col. 20, lines 14-15. Therefore, Martin cannot anticipate the agricultural composition of claim 32. Having overcome the rejection, Applicants request that the finality of the rejection be withdrawn.


Finally, Applicants wish to point out an error in Applicants’ Reply of August 27, 2008. On page 11 of the Reply, the structures of “Example 29” and “Comparative A” are transposed. This error does not in any way affect the data or the substance of the Reply.

For the foregoing reasons, Applicants request withdrawal of all rejections and favorable consideration of all pending claims. A Notice to this effect is respectfully requested. If any questions remain, the Examiner is invited to contact the undersigned at the number given below.

Respectfully submitted,

BRINKS HOFER GILSON & LIONE

Date: MARCH 16, 2009

By: 
Bryan L. Skelton
Registration No. 50,893

2801 Slater Road, Suite 120
Morrisville, NC 27560
919.481.1111
667586v1